

Attorney Docket No.: 1115-005U

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 29973
	:	
Thomas DISTEFANO, III	:	Confirmation Number: 9812
	:	
Application No.: 09/405,731	:	Group Art Unit: 3628
	:	
Filed: September 24, 1999	:	Examiner: C. Brown
	:	
For:		MODERATING EXTERNAL ACCESS TO AN ELECTRONIC DOCUMENT AND AUTHORING DEVELOPMENT AND DISTRIBUTION SYSTEM

REQUEST FOR RECONSIDERATION

Mail Stop Amendment
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following Remarks are submitted in response to the Office Action dated May 4,
2006.

REMARKS

At the time of the Office Action dated May 5, 2006, claims 1-20 were pending and rejected in this application.

**CLAIMS 1 AND 3-4 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY
DELORME ET AL., U.S. PATENT NO. 5,948,040 (HEREINAFTER DELORME)**

On pages 2 and 3 of the Office Action, the Examiner asserted that DeLorme discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.² This burden has not been met.

Independent claim 1 is directed to an electronic document authoring, development, and distribution system. However, upon reviewing the Examiner's statement of the rejection and the teachings of DeLorme, Applicant notes that the Examiner has failed to establish that DeLorme teaches an electronic document authoring, development, and distribution system. Specifically, claim 1 recites that the system must be capable of electronic document authoring, electronic

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

² Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., *supra*.

document development, and electronic document distribution. In contrast, DeLorme is directed to "systems that permit individuals to make travel arrangements and to plan travel activities" (column 1, lines 29-31).

Although the passages cited by the Examiner (i.e., column 37, lines 25-53 and column 46 lines 8-57) in the statement of the rejection discuss different access privileges to the Travel Reservation and Information Planning Systems (TRIPS) site, Applicant is unable to determine where DeLorme teaches that the TRIPS site of DeLorme is capable of electronic document authoring, electronic document development, and electronic document distribution. Applicant, therefore, respectfully submits that DeLorme fails to identically disclose the claimed invention, as recited in claims 1 and 3-4, within the meaning of 35 U.S.C. § 102.

CLAIMS 2 AND 5-20 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON DELORME IN VIEW OF PERKOWSKI, U.S. PATENT NO. 6,959,286

On pages 3-12 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify DeLorme in view of Perkowski to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 2 and 5-10 depend ultimately from independent claim 1 and claims 11-20 are substantially similar to claims 1-10, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for anticipation based upon DeLorme. Specifically, the Examiner has failed to establish that the TRIPS site of DeLorme is capable of electronic document authoring, electronic document development, and

electronic document distribution, as claimed. The secondary reference to Perkowski does not cure the argued deficiencies of DeLorme. Accordingly, even if the claimed invention were combined in the manner suggested by the Examiner, the proposed combination of references would not yield the claimed invention.

Moreover, Applicant notes that the Examiner did not rely upon Perkowski in the statement of the rejection with regard to claims 2 and 5. Instead, the Examiner asserted that one having ordinary skill in the art would have been motivated to modify DeLorme based upon DeLorme's own teachings. The Examiner, however, has not establish any realistic benefit for the modification. In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to identify a source in the applied prior art for: (1) claim limitations; and (2) the motivation to combine references or modify a reference in the reasonable expectation of achieving a particular benefit.³ In this regard, Applicant notes that the Examiner has failed to provide a source in DeLorme for either.

With regard to Perkowski, Applicant respectfully submits that Perkowski is non-analogous prior art that cannot be applied against the claimed invention. Whether a prior art reference is from a nonanalogous art involves (a) determining whether the reference is within the same field of endeavor and (b) determining whether the reference is reasonably pertinent to the particular problem with which the invention is involved.⁴ If the prior art is outside the inventor's field of endeavor, the inventor will only be presumed to have knowledge of prior art that is reasonably pertinent to the problem being addressed.⁵ The Examiner is also charged to consider "'the reality of the circumstances' ... in other words, common sense" to determine what field a

³ Smiths Industries Medical System v. Vital Signs Inc., 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999).

⁴ In re Clay, 23 USPQ2d 1058 (Fed Cir. 1992).

⁵ In re Wood, 202 USPQ 171 (C.C.P.A. 1979).

person of ordinary skill in the art would reasonably be expected to look.⁶ With regard to this issue, the Examiner is also referred to M.P.E.P. § 2141.01, entitled "Analogous and Nonanalogous Art."

Perkowski is directed to a "system and method for collecting consumer-product related information and transmitting and delivering the same along the consumer-product supply and demand chain using ... the Internet." This system is unquestionably not within the same field of endeavor as Applicant's invention, and the Examiner has not established that Perkowski is reasonably pertinent to the particular problem in which Applicant's invention is involved. Therefore, the Examiner has improperly applied Perkowski against the claimed invention.

Furthermore, the Examiner has failed to establish a proper motivation to modify DeLorme in view of Perkowski. The Examiner's stated benefit (i.e., "to deliver consumer product related information to consumers within retail environments using the internet based servers and sales agents") is not reasonably related to the Examiner's proposed modifications. The Examiner's stated motivation is derived from column 1, lines 21-29 of Perkowski, which is just a general description of Perkowski's disclosure. The Examiner, however, has not established what particular benefits flow from the specific proposed modifications, based upon the teachings of Perkowski, and where these benefits are taught by Perkowski.

Therefore, for the reasons stated above, Applicant respectfully submits that the imposed rejection of claims 2 and 5-20 under 35 U.S.C. § 103 for obviousness based upon DeLorme in view of Perkowski is not viable and, hence, solicits withdrawal thereof.

⁶ In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

Although Applicant believes that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 503839, and please credit any excess fees to such deposit account.

Date: September 5, 2006

Respectfully submitted,

/s/ Scott D. Paul

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

CUSTOMER NUMBER 29973